

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRIS J. KAY, SCOTT A. KITTLSTAD, ROBERT D. LECLARE,
JOE A. INZEO and BRAD M. WHITE

Appeal No. 2004-1274
Application 09/951,616

ON BRIEF

Before FLEMING, RUGGIERO, and GROSS, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-23.

Invention

Appellants' invention relates to a coping assembly 10 for covering the top of a wall 12 extending upwardly from a roof 14 of

a building. See Appellants' Fig. 1 and specification, page 3, lines 23 and 24. The coping assembly 10 includes first and second elongated coping sections 38 and a splice plate 88. See Appellants' specification, page 6, lines 1 and 2. The second coping section 38 is positioned in an end-to-end relationship with the first coping section 38 and spaced from the first coping section 38 to define a gap 90 between the coping sections 38 such that a portion 92 of the splice plate 88 is visible through the gap 90 as seen in Fig. 5. See Appellants' specification, page 6, lines 2-5. The portion 92 of the splice plate 88 includes a formed groove 102 that has the appearance of a mortar reveal that extends across the center of the splice plate 88. See Appellants' specification, page 6, lines 21 and 22.

Claim 1 is representative of the claimed invention and is reproduced as follows:

A coping assembly for covering the top of an exterior wall that extends upwardly from a roof of a building, the wall including a top surface, a forward face, and a rear face, the coping assembly comprising:

a first elongated coping section including an end, the first coping section mounted on the top of the wall to cover a first portion of the wall;

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a second elongated coping section including an end, the second coping section mounted on the top of the wall to cover a second portion of the wall, the second coping section being positioned in an end to end relationship with the first coping section and spaced from the first coping section; and

a splice plate positioned beneath a portion of the first and second coping sections, the splice plate including a portion that extends between the first and second coping sections, wherein the portion of the splice plate includes a formed groove having the appearance of a mortar reveal.

References

The references relied on by Examiner are as follows:

Castle	5,289,662	Mar. 1, 1994
Koenig et al. (Koenig)	5,263,294	Nov. 23, 1993

Rejection at Issue

Claims 1-23 stand rejected under 35 U.S.C. § 103 as being obvious over Castle in view of Koenig.

OPINION

With full consideration being given to the subject matter on appeal, Examiner's rejections and the arguments of Appellants and Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 1-23 under 35 U.S.C. § 103.

At the outset, we note that Appellants state on page 9 of the brief that claims 1 through 23 are presented in a single group. 37 CFR § 1.192 (c)(7) (July 1, 2003) **as amended at** 62 Fed. Reg. 53196 (October 10, 1997), which was controlling at the time of Appellants filing the brief, states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider the Appellants' claims as standing or falling together and we will treat claim 1 as a representative claim of that group. **See In re McDaniel**, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) ("If the brief fails to meet either requirement [of 37 CFR § 1.192 (c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.") **See also, In re**

Watts, 354 F.3d 1362, 1368-69, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met, does the burden of coming forward with evidence or argument shift to Appellant. **Oetiker**, 977 F.2d at 1445, 24 USPQ at 1444. **Piasecki**, 745 F.2d at 1472, 223 USPQ at 788. An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument."

In re Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he board must not only assure that the requisite findings are made, based on

evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion."

In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

The Examiner states that Castle teaches all limitations of claim 1 except "a formed groove having the appearance of a mortar reveal." See page 2 of the Examiner's final rejection on May 9, 2003 (hereinafter "final"). The Examiner further states that Koenig teaches the groove having the appearance of a mortar reveal. See page 3 of the final.

Appellants do not dispute the Examiner's finding that the combination of Castle and Koenig teaches all limitations of claim 1. Appellants argue that one of ordinary skill in the coping assembly art would not look to the wall board installation art because coping assemblies deal with protecting a roof wall from the harsh elements of outside environment, which is not a design consideration for wall boards used in environmentally controlled interior rooms. See last paragraph on page 11 of the brief.

Before we consider whether there are reasons for combining the teachings of Castle and Koenig, we first must consider the scope of the claim. "[T]he name of the game is the claim."

In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). "In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification." **In re Bass**, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. Dec. 2002). **Citing In re Yamamoto**, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). Words in a claim are to be given their ordinary and accustomed meanings unless the inventor chooses to be his own lexicographer in the specification. **In re Bass**, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002), **citing Lantech, Inc. v. Keip Mach. Co.**, 32 F.3d 542, 547, 31 USPQ2d 1666, 1670 (Fed. Cir. 1994).

We note that the recitation "wherein the portion of the splice plate includes a formed groove having the appearance of a mortar reveal" as recited in claim 1 is not limited to a finished wall after installing of the coping assembly. We note the language is only directed to the splice plate itself. Thus, only

the splice plate includes a groove having the appearance of a mortal reveal. Furthermore, we find that Appellants' specification does not provide a definition for a mortal reveal. On page 1 of Appellants' specification, it is stated that "stones are joined by mortar and the combination of the stones and the mortar joints provide an aesthetically pleasing appearance". The only other aid to the definition is found on page 6 of Appellants' specification stating "the color of the splice plate is different from the color of the coping sections 38 such that the portion 92 of the splice plate that is displayed in the gap 90 between the coping sections 38 contrasts with the color of the coping sections 38 to give the coping assembly 10 the appearance of a stone and mortar joint coping assembly." Furthermore, when we consult Webster's Dictionary, we find that "mortar" is defined as "a mixture of cement or lime with sand and water, used between bricks or stones to bind them together" and that "reveal" is defined as "to expose to view; show; exhibit; display."¹ Thus, we find that the broadest reasonable interpretation of Appellants' claim 1 requires that a portion of the splice plate

¹Webster's New World Dictionary, Third College Edition, 1988, pages 884 and 1148. Copy provided to Appellants.

be exposed to view and have a different color than the coping sections.

We find that Castle teaches a splice plate 22 having a neoprene sealant strip 44 that is exposed to view. See Castle's Figures 5 and 6 and column 2, line 40, through column 3, line 32. Also, we note that the neoprene is notoriously well known to be dark brown or black and would be a different color than the coping sections which are conventionally silver or white.

Therefore, we find that Castle teaches all elements of Appellants' claim 1.

Turning to the issue of whether the Examiner has properly combined Castle and Koenig, our reviewing court states:

While this court indeed warns against employing hindsight, its counsel is just that - a warning. That warning does not provide a rule of law that an express, written motivation to combine must appear in prior art references before a finding of obviousness. Stated differently, this court has consistently stated that a court or examiner may find a motivation to combine prior art references in the nature of the problem to be solved.

Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1275-76, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). **Also See Pro-Mold**, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996); **Display Techs., Inc. v. Paul**

Flum Ideas, Inc., 282 F.3d 1340, 1346-47 (Fed. Cir. 2002); **In re Huang**, 100 F.3d 135, 139 n.5, 40 USPQ2d 1685, 1688 n.5 (Fed. Cir. 1996).

In the instant case, Castle recognizes the following problem:

Although the known coping system described and illustrated in FIG. 1 has served the purpose, it has not been entirely satisfactory because central web portion 34 of splice plate 18 often sags from its own weight or from the weight of water or ice. Such sagging is undesirable because it allows collection of water and also tends to distort and damage sealant strips 20, 20'. This, in turn, allows moisture to pass around or over sealant strips 20, 20' and into wall 12 in an undesirable manner.

See in column 1, lines 34-42, emphasis added.

In other words, Castle recognizes the problem of deterioration of the sealant or caulk 20 and 20' between joints that enables water or moisture to enter into the wall 12 in the conventional coping system in Fig. 1.

Koenig also recognizes the same problem of deterioration of the sealants between joints that enables water or moisture to enter the wall. Koenig teaches that tiled walls have been long popular for bathrooms and kitchens. Koenig further teaches that it is known that these walls present certain problems. One of the problems is the grout between the tiles can deteriorate which

enables water or moisture to enter into the wall. See Koenig, column 1, lines 11-23. Koenig then teaches that prior art wall boards that are eight feet high by four feet wide have been used to solve the problem, but the joint between the wall boards presents the same problem of deterioration of the sealant as well as the additional problem of difficulty of having the sealant applied in a way to give the appearance of grout lines between the wall boards. See Koenig, column 1, lines 24-46. Koenig solves this problem by providing an extension joint that acts as a simulated grout line without the necessity of caulking or grouting between wall boards. See Koenig, column 1, line 47, through column 2, line 7.

Thus, Koenig recognizes the same problem that Castle recognized that the deterioration of the sealants between the joints allows water to enter the wall. Thus, both Castle and Koenig are attempting to solve the same problem. Castle and Koenig both recognized the problem of dealing with joint sealants between moisture barriers (coping elements 26 or wall board panels 40). Thus, one of ordinary skill in the art would be motivated to use the Koenig solution in the Castle wall coping system to solve the

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problem of sealants and the difficulty of providing the seamless appearance of grout or mortar lines for the Castle wall coping system so as to prevent undesirable entry of moisture into the wall while at the same time providing an aesthetically appealing seamless appearance.

For the foregoing reasons, we find that the Examiner has established a **prima facie** case of obviousness. Therefore, we will affirm the rejection of claims 1-23 under 35 U.S.C. § 103.

Appellants have not made any other further argument as to the claims. 37 CFR 1.192(a) states:

Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which Appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

Thus, 37 CFR § 1.192(a) provides that only arguments made by Appellants in the brief will be considered and that failure to make an argument constitutes a waiver on that particular point.

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Support for this rule has been demonstrated by our reviewing court in **In re Berger**, 279 F.3d 975, 984, 61 USPQ2d 1523, 1528-29 (Fed. Cir. 2002), wherein the Federal Circuit Court stated that because the Appellant did not contest the merits of the rejections in his brief to the Federal Circuit court, the issue is waived. Our reviewing court has stated that the court has "frequently declined to hear arguments that the applicant failed to present to the Board." **In re Watt**, 354 F.3d at 1368-69, 69 USPQ2d at 1457-58 (Fed. Cir. 2004).

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR §
1.136(a).

AFFIRMED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
)	
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JOSEPH F. RUGGIERO)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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